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10/027,829	10/19/2001	Brian N. Tufte		2577

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EXAMINER

BORISSOV, IGOR N

ART UNIT PAPER NUMBER

3639

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/027,829

Applicant(s)

TUFTE, BRIAN N.

Examiner

Igor Borissov

Art Unit

3639

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 March 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 32 is rejected under 35 U.S.C. 112, first paragraph, for lack of Adequate Written Description.

In accordance with 37 CFR § 1.75, a preamble comprises a general statement of all the elements of steps of the claimed combination, which are conventional or known. Original Claim 32 includes the following language: "...*wherein the donations are assigned to one or more delivery lots of cash, goods and/or services*". However, the specification does not have adequate description of this fact. Therefore, Claim 32 is rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-23 and 25-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per independent Claims 1, 20, 25, 30 and 32, the preambles of said Claims indicate that said method is for "*increasing the participation of contributors that provide donations*". However, there is nothing in the body of said Claims which would indicate how said "*increasing*" is conducted.

The remaining depended Claims are rejected as being dependent from said independent Claims.

***Claim Rejections - 35 USC § 101***

**35 U.S.C. 101 reads as follows:**

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1, 6, 8-11, 13, 15-21, 23, 25-28 and 30-32 are rejected under 35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter. The claimed invention is not within the technological arts.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful,

Art Unit: 3639

concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

*The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. In re Toma at 857.*

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the "mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement

Art Unit: 3639

issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and Interferences (BPAI) in affirming a §101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

Contrary to the claims in the above-cited cases, in the present application, the claims are completely silent with regard to technology and is purely an abstract idea or process steps that are employed completely without the use of any technology whatsoever. The method claims are no more than a suggested idea of receiving a donation, possibly money, from a contributor, and informing the contributor about how said money would be spent. The claims are completely devoid of any means to carry out a process implementing the step of *receiving a donation; assigning the donation to a delivery lot of cash, goods and/or services; obtaining the location of the delivery lot at one or more points in time; and providing the location of the delivery lot to the contributor.*

Section 100 (b) of Title 35 U. S. C. defines "process" to mean "process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material." "When Congress approved the addition of the term "process" to the categories of patentable subject matter in 1952, it incorporated the definition of "process" that had evolved in the courts" (footnotes omitted), See *In re Schrader*, 22 F. 3d 290, 295, 30 USPQ2d 1455, 1459 (Fed. Cir. 1994), which included

Art Unit: 3639

this definition from *Cochrane v. Deener*, 94 U. S. 780, 788 (1877): “A process is ... an act, or series of acts, performed upon the subject matter to be transformed and reduced to a different state or thing.”

Claims in the present application do not transform any physical subject matter or tangible (matter) into a different state of thing, and can be performed manually by a human.

The examiner recognizes that a statutory “process” under § 101 does not have to be performed by a machine, there must be a transformation of physical subject matter from one state to another, e.g., a step of “mixing” two chemicals transforms two separate chemicals into a manufacture or a composition of matter, regardless of whether it is performed by a human or a machine.

Claims in the present application do not recite transformation of physical subject matter.

The examiner further recognizes that “subject matter” transformed does not need to be a physical (tangible) object or article or substance. Under the State Street test transformation of electrical signals into a different state or signal within a computer could constitute a machine implementation if the result has some practical utility. Furthermore, in accordance with MPEP 2106 (IV)(B)(2)(b) “Statutory Process Claims”, not all processes are statutory under 35 U.S.C. 101. *Schrader*, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts. See *Diamond v. Diehr*, 450 U.S. at 183-184, 209 USPQ at 6 (quoting *Cochrane v. Deener*, 94 U.S. 780, 787-788 (1877)).

The claims in the present application do not appear to satisfy either of the two conditions listed above. First, the claims do not include limitations that would suggest a computer is being used to transform the data from one form to another that would place the invention in the technological arts. Second, disregarding the fact that there is no computer claimed that would physically transform the data, there does not appear to be

Art Unit: 3639

any physical transformation of data. Thus, there neither appears to be any physical transformation of data from one form to another, which is based upon an algorithm or a calculation by a computer or processor, nor is there any technology claimed that would be used to transform the data.

Because the independently claimed invention is directed to an abstract idea which does not recite a limitation in the technological arts, those claims are not permitted under 35 USC 101 as being related to non-statutory subject matter. However, in order to consider those claims in light of the prior art, examiner will assume that those claims recite statutorily permitted subject matter.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-5, 7-13, 15-22, 24-28 and 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by the AllCharities.com.**

#### **Independent Claims**

Claims 1, 20 and 24. The Internet printout of AllCharities.com web site (Publication) of 02/08/2000, appears to teach a web site wherein a plurality of contributors can make a donation including money, goods or services to individuals or organizations (Pages 1-3; See examiner's numeration on the top of each page). The location of each organization (delivery lot) is provided at any point in time (Page 2).

Claim 25. Publication appears to teach a web site wherein a plurality of contributors can make a donation including money, goods or services to individuals or organizations, wherein the location of each organization (delivery lot) is provided (Pages 1-3); and reporting (mailing a letter of acknowledgement) information relating to the



Art Unit: 3639

delivery of the delivery lot to the contributors (Page 5, second paragraph). Providing the location of each organization (delivery lot) for the selected donation indicates assigning step.

Furthermore, the examiner notes that the Applicant has admitted that assigning the donations to one or more delivery lots of cash, goods and/or services is known (See preamble of Claim 32).

Claim 30. Publication appears to teach a web site wherein a plurality of contributors can make a donation including money, goods or services to individuals or organizations, wherein the contributors can choose the desired organization from the list displayed on the web site, and wherein the location of each organization (delivery lot) is provided (Pages 1-3).

Claim 32. Publication appears to teach a web site wherein a plurality of contributors can make a donation including money, goods or services to individuals or organizations, wherein the location of each organization (delivery lot) is provided (Pages 1-3). Providing the location of each organization (delivery lot) for the selected donation indicates assigning step.

#### Dependent Claims

Claims 2 and 12. See reasoning applied to Claim 1.

Claim 3. Receiving a contributor's name (Page 7).

Claims 4 and 5. Receiving a contributor's payment information (Page 8, 6<sup>th</sup> paragraph).

Claim 7. Receiving information via email (Page 10).

Claims 8-10 and 16. Publication appears to teach a web site wherein a plurality of contributors can make a donation including money, goods or services to individuals or organizations (Pages 1-3). Language as to: "wherein the cash, goods and/or services includes food, medicine or cash" or "wherein the delivery lot includes two or more types of cash, goods and/or services" is given no patentable weight. MPEP 2106 (II) (C) states: "*Language that suggests or makes optional but does not require steps to*

Art Unit: 3639

*be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation."*

Claims 11, 13, 15, 17 and 19. See reasoning applied to Claim 1.

Claim 18. See reasoning applied to Claim 1. Language as to: " wherein two or more donations are assigned to a common delivery lot" is given no patentable weight. MPEP 2106 (II) (C) states: "*Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation."*

Claims 21-22. Publication appears to teach a web site wherein charitable organizations are identified in order to be selected, each charitable organization included a unique name and location (Page 3; Page 8, 3<sup>rd</sup> paragraph).

Claims 26-27. See reasoning applied to Claim 1. Language as to: " wherein the contributors include individuals or organizations with organization members" is given no patentable weight. MPEP 2106 (II) (C) states: "*Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation."*

Claim 28. See reasoning applied to Claim 25. Language as to: "one or more members of the contributing organizations" is given no patentable weight. MPEP 2106 (II) (C) states: "*Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation."*

Claim 31. Reviewing by the contributors their "e-Giving" history indicates obtaining location information for the delivery lot after the delivery lot is sent (Page 6).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Publication in view of Redcross.org.**

Publication teaches all the limitations of Claim 6, except specifically teaching that the information related to the donation is received via the phone.

The Internet printout of Redcross.org web site (Redcross) of 01/22/1998, appears to teach a web site wherein information related to donations can be obtained via the phone (1-800-HELP-NOW and 1-800-Give Life) (Page 1).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Publication to include that the information related to the donation can be received via the phone, as disclosed in Redcross, because it would advantageously allow to make donations to those contributors who do not have an access to the Internet.

**Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Publication.**

Claim 14. Publication teaches all the limitations of Claim 14, except explicitly teaching that location of said delivery lot is provided to the contributor via email. However, Publication does teach providing the contributors with contact information including email. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Publication to include that location of said delivery lot is provided to the contributor via email, because it would advantageously allow the contributor to obtain the desired information without spending time for searching for said desired information.

**Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Publication in view of Robbins (US 2003/0182265).**

Art Unit: 3639

Claim 23. Publication teaches receiving donations (money, goods or services) made by the contributors by the Internet Giving Foundation, a 501(c)(3) pub that acts as a pass-through recipient for the donations, and distributing said received donations to charities selected by the contributors (Page 9, 2<sup>nd</sup> paragraph). However, Publication does not specifically teach obtaining the location of each delivery lot at two or more points in time, each corresponding to a different location.

Robbins teaches delivery tracking method and system, wherein a shipper of a package is able to track the delivery of the package via the Internet at one or more points in time [0020]; [0027].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Publication to include obtaining the location of each donation at one or more points in time, as taught by Robbins, because it would advantageously allow to retrace the delivery root in case the package of the goods ordered is lost, thereby increasing the reliability of the system.

**Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Publication in view of O'Donnell et al. (US 2002/0013739).**

Claim 29. Publication teaches all the limitations of Claim 29, except providing a chat room.

O'Donnell et al. (O'Donnell) teaches a method and system for making donations via shipping services, wherein chat rooms are provided [0146].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Publication to include providing chat rooms, as taught in O'Donnell, because it would promote said donations by allowing involved participants to communicate in real time.

### ***Response to Arguments***

Applicant's arguments with respect to Claims 1-32 have been considered but are moot in view of the new ground(s) of rejection.

Art Unit: 3639

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication should be directed to Igor Borissov at telephone number (571) 272-6801.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's Supervisor, John Weiss, can be reached at (571) 272-6812.

Any response to this action should be mailed to:

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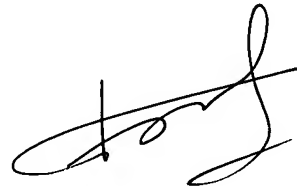
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communications labeled "Box AF"]

Igor Borissov  
Patent Examiner  
Art Unit 3639

A handwritten signature in black ink, appearing to be 'Igor Borissov', written in a cursive style.

IB

5/31/2005